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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,240	07/17/2006	Noriko Sugimoto	2006_0986A	1802
52349 7590 05/27/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
COPPOLA, JACOB C				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
05/27/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/586,240

Applicant(s)

SUGIMOTO ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date 17 July 2006, 04 February 2008, 09 June 2008, 20 October 2008, and 24 March 2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office action is in response to Applicants' response to notice of non-responsive elections filed on 22 February 2010.
2. Claims 1-18 are currently pending.
3. Claims 1-7, 13, 17, and 18 have been examined.
4. Claims 8-12 and 14-16 have been withdrawn, as noted below.
5. Unless expressly noted otherwise, all references in this Office Action (or in any future office action(s)) to the capitalized versions of "Applicant," "Applicant(s)," or "Applicants" refer specifically to the Applicant of record. Conversely, references to lower case versions of "applicant," "applicant(s)" or "applicants" refer not to the Applicant of record but to any one or all patent applicant(s) generally. Unless expressly noted otherwise, references to the capitalized version of "Examiner" in this Office Action (or in any future office action(s)) refers specifically to the Examiner of record while reference to or use of the lower case version of "examiner," "examiner(s)," or "examiners" refers to examiners generally.
6. This Office Action is given Paper No. 20100517. This Paper No. is for reference purposes only.

Restrictions

7. Applicants' election of claims 1-7, 13, 17, and 18 in the reply filed on 22 February 2010 is acknowledged. Because Applicants did not distinctly and specifically point out the supposed

errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

8. Claims 8-12 and 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 22 February 2010.

Continuation in Part

9. This application is a national stage entry of PCT/JP05/01548 filed internationally on 27 January 2005. PCT/JP05/01548 is a continuation-in-part ("CIP") application of U.S. application no. 10/764,470 filed on 27 January 2004 ("Parent Application"). See MPEP §201.08. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicants are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 A. 2. Finally, Applicants are reminded that the prosecution history of the Parent Application is relevant in this application.

Information Disclosure Statement

10. The Information Disclosure Statements filed 17 July 2006, 04 February 2008, 09 June 2008, 20 October 2008, and 24 March 2010 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Rejections - 35 USC §101

11. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-7, 13, 17, and 18 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1-7, 13, and 18

13. Claims 1-7 and 18 recite computer programs only. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention¹.

¹ 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

Because the claims are **not** within one of the four statutory classes of invention, the claim(s) are rejected under 35 U.S.C. §101.

14. Additionally, the Examiner notes that using the broadest reasonable interpretation of “unit,” as noted below, the claimed units are interpreted as software only. Because the broadest reasonable interpretation of “module” includes software only, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

15. Additionally, claims 1-7, 13, and 18 are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. Accordingly, claims 1-7, 13, 17, and 18 are rejected under §101.

Regarding Claim 17

16. As recited, claim 17 is directed to “[a] program.” However, under the current guidelines of 35 U.S.C. §101, a computer program must be tangibly embodied on a non-transitory computer readable medium, and, when executed by a computer processor, causes the computer processor to perform a method. In its broadest reasonable interpretation and in light of the specification, claim 17, as recited, can be interpreted to be embodied as software *per se*, and therefore not eligible for patent protection.

Claim Rejections - 35 USC §112, First Paragraph

17. The following is a quotation of the first paragraph of 35 U.S.C. §112:

(a) The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 1-7, 13, and 18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Regarding Claims 1-7, 13, and 18

19. Claims 1-7, 13, and 18 are rejected under 35 U.S.C. §112, first paragraph (scope of enablement), because the claimed “unit[s] operable to...” are purely functional recitations with no limitation of structure. See *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-17 (B.P.A.I. 2008)(precedential). See also *Ex parte Rodriguez*, 92 USPQ2d 1395 (B.P.A.I. 2009).

20. The “unit operable to...” language of claims 1-7, 13, and 18 does not require claim interpretation under 35 U.S.C. §112, sixth paragraph, as noted below in § “Claim Interpretation.” As such, the claim elements “unit operable to...” are purely functional recitations in that there is no structure presented in the claim element itself, and the Examiner is not required to import structure from the Specification into the claim under 35 U.S.C. §112, sixth paragraph. Nor is there any evidence that one of ordinary skill in the art could understand such terms to have a definite structural meaning.

21. Because the structure for each “unit” can be interpreted to encompass all structures for performing the respective claimed functions, the Examiner adopts the reasoning from *Miyazaki* and rejects claims 1-7, 13, and 18 under 35 U.S.C. §112, first paragraph (scope of enablement).

Claim Rejections - 35 USC §112, Second Paragraph

22. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

23. Claim 1-7, 13, 17, and 18 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claims 1-7, 13, and 18

24. Claims 1-7, 13, and 18 are indefinite because they are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

25. For example, claim 1 recites “A playback apparatus for optical discs....” Moreover, claims 2-7 recite “The playback apparatus of claim [x]....” In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, claim 1 recites “a playback unit operable to, *when* the judging unit judges in the affirmative, play back a content...” (emphasis added). One

of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. This interpretation hinges on Applicants use of “when.” The use of “when” requires the function of the playback unit to only be performed after other actions (or conditions), namely the actions of the judging unit. Accordingly, the function of the playback unit, which is a conditional function based upon the action of the judging unit, is not an element of the structure of the system, as claimed, but instead relates to a process of interrelated functions carried out by the playback unit and judging unit. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 1 to be drawn to either a product or process.

26. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, second paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

Regarding Claims 2-7

27. Claims 2-7 are indefinite because it is unclear to one of ordinary skill in the art whether Applicant is claiming the subcombination of “the playback apparatus” or the combination of “the playback apparatus” and “the server apparatus.”

28. If it is Applicants’ intent to claim only the subcombination, the body of the claims must be amended to remove any positive recitation of the combination. If it is Applicants’ intent to

claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. For the latter, the Examiner recommends claiming “a system.”

Regarding Claim 17

29. Claim 17 recites “A program that has a computer execute playback processing of optical discs, comprising....” The phrase “a computer execute playback processing” renders the claim vague and indefinite.

30. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC §102

31. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

32. Claims 1-7, 13, 17, and 18, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Yamada et al. (U.S. 6,141,483 A) (“Yamada”).

Regarding Claims 1-7, 13, 17, and 18

33. Yamada discloses:

a judging unit (“control unit 11”) operable to judge whether a disc region code assigned to an optical disc matches an apparatus region code assigned to the playback apparatus;

a playback unit (“recording unit 12”) operable to, (i) when the judging unit judges in the affirmative, play back a content recorded on the optical disc, and (ii) when the judging unit judges in the negative, not play back the content except when an exceptional playback is authorized,

wherein the exceptional playback is authorized when a combination of a content identifier of the content and the apparatus region code satisfies a predetermined condition defined by a right owner of the content.

Claim Interpretation

34. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

35. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

36. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases "to," "for," "adapted to," or other functional language (e.g. claim 1 recites "a judging unit operable to judge whether a disc region code...") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all claims currently pending.

37. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.² Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

² While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

operable “1 : fit, possible, or desirable to use.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986;

to “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

unit “(3) A software component that is not subdivided into other components.” IEEE Standard Computer Dictionary, The Institute of Electrical and Electronics Engineers, New York, NY, 1990; and

when “2 : in the event that: IF.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Conclusion

38. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

a. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, first paragraph.

b. Independent of the requirements under 35 U.S.C. §112, first paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms

must have clear support or antecedent basis in the specification. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP §608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. §132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

39. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached at (571) 272-6779.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3621

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/

Patent Examiner, Art Unit 3621

May 17, 2010

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621